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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/879,823

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Craig W. Barnett

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EXAMINER

DURAN, ARTHUR D

ART UNIT

PAPER NUMBER

3622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/18/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/879,823

Applicant(s)

BARNETT ET AL.

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 47 and 52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 47 and 52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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DETAILED ACTION

1. Claims 47 and 52 have been examined.

Response to Amendment

2. The Amendment filed on 10/10/06 is insufficient to overcome the rejection.

Examiner further notes that this office action is in response to the February 8, 2006 decision by the Board of Patent Appeals and Interferences (BPAI) which affirmed the Examiner in the rejection of the claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 47 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Von Hohorn (5,227,874) in view of Saigh (5,734,823).

Claims 47, 52:

VonKohorn discloses:

storing, at an network-accessible location, information pertaining to a group of available coupons, including information about one or more target audiences of users for which one or

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more coupons have been designated (col 98, lines 39-45; col 98, lines 57-65; col 105, lines 15-30);

prompting a user to register over the network to be able to print coupons, if the user is not already registered;

receiving registration information from the user (col 3, line 56-66; col 94, lines 1-12; col 94, lines 56-62; col 97, lines 64-70; col 103, line 62-col 104, line 2; Fig. 30; col 109, lines 10-16);

downloading to the computer a unique identifier (col 109, lines 10-16);

receiving, at the network-accessible location, a request from the user for access to at least some of the stored coupon information, wherein the unique identifier is transmitted with the request, and one or more routines are implemented at the network-accessible location to confirm the unique identifier to ensure validity (claims 5 and 6);

displaying coupon information for at least the one or more coupons designated for at least one of the audiences for which the user is a member (col 98, lines 39-45; col 98, lines 57-65; col 105, lines 15-30)

receiving selection information from the user for one or more coupons that the user desires to print based on the displayed coupon information (col 98, lines 39-45; col 98, lines 57-65; col 105, lines 15-30);

printing, via a printer associated with the computer, one or more user-selected coupons based at least in part on instructions from the coupon data management software which is invoked when a user selects a print command (Fig. 30); and

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monitoring redemption of the one or more user-selected coupons to prevent fraud (col 17, lines 10-31; col 20, lines 38-44; col 86, lines 10-25; col 87, lines 59-65).

Von Kohorn further discloses the coupon data management software being used at least in connection with the printing of coupons (col 109, lines 10-16).

Also, Von Kohorn discloses enabling a user to download coupon data management software to the at least one remote user computer system to be used at least in connection with the printing of coupons.

Von Kohorn discloses downloading or transmitting instructional signals and programming routines (col 2, lines 55-60; col 109, lines 10-16; col 14, lines 20-25; col 20, lines 57-65; col 26, lines 45-52; col 6, line 56-col 7, line 27).

Von Kohorn further discloses that the programming instructions are ordered as a module or in a group (col 5, lines 31-45; col 4, line 21-35; col 41, lines 28-60).

Von Kohorn further discloses that the programmed response unit can print incentives (col 2, lines 52-56; col 39, lines 24-31; col 41, lines 52-60; col 19, lines 29-34; col 20, lines 57-64; col 22, lines 49-55; col 34, line 67-col 35, line 6).

Also, Von Kohorn discloses that the user's system is specified as a remote system (Fig. 2; page 20, lines 7-11). Furthermore, the printer's are associated with the user's system (page 16, lines 5-10).

Also, Von Kohorn discloses that instructional signals can be transmitted for managing or adjusting coupons:

“(85) The latter method has the advantage that a sponsor or advertiser can have up-to-date promotional information printed on coupons by directing the station which transmits

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instructional signals to remote locations to include in such signals the desired advertising material. A last-minute-telephone call by an advertiser to the sub-carrier station with directives to incorporate certain instructional signals in the sub-carrier transmission will result in a large number of shoppers being alerted to special sales through up-to-the-minute coupon promotions” (col 19, lines 29-39).

Hence, Von Kohorn discloses downloading or transmitting instructional signals and programming routines where the programming instructions can be ordered as a module or in a group that is utilized for coupon adjusting, coupon managing, coupon printing which is functionally equivalent to downloading to the one or more remote user systems an incentive data management software module.

Also, Von Kohorn further discloses that the method can utilize a variety of networks (col 44, line 45-col 45, line 15; col 88, line 55- col 89, line 15).

Von Kohorn does not explicitly disclose that the communication channel can be the Internet.

However, Saigh discloses the utilization of the Internet for the dissemination of a variety of information (col 1, lines 38-41; col 5, lines 20-30), that coupons can be transmitted to users (col 14, lines 60-65; col 8, lines 3-6; col 14, line 15-col 15, line 10) and that the coupons can be printed (col 8, lines 59-61).

Saigh further discloses that the service system is associated with an Internet web site (col 14, lines 15-21).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Saigh’s utilization of the Internet to Von Kohorn transmitting

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coupons. One would have been motivated to do this because the Internet is a readily available network for transmitting information.

Von Kohorn does not explicitly disclose wherein the unique identifier is encrypted and transmitted with the request, and one or more routines are implemented at the Internet-accessible location to decrypt the unique identifier to ensure validity.

However, Von Kohorn discloses the utilization of encryption related to identifying indicia (col 10, lines 40-45) and Von Kohorn discloses encoding and decoding (Fig. 7, 'Coder'; Fig. 8, 'Decoder').

Saigh further discloses utilizing encryption or encoding (col 15, lines 10-16; claim 10; col 15, line 10-col 17, line 32).

Von Kohorn further discloses the user transmitting the unique user identifier and also that the user identifier can be a code (col 61, lines 34-55; col 105, lines 51-65; claims 5, 6).

Von Kohorn further discloses that codes, encoding, and encryption are related (col 10, lines 40-45).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Von Kohorn transmitting of unique user identifiers in the form of codes can also be in the form of encryption. One would have been motivated to do this in order to better secure the validity of the unique identifier of the user.

Alternatively, Von Kohorn discloses encoding and decoding (Fig. 7, 'Coder'; Fig. 8, 'Decoder'). Von Kohorn discloses the central station encoding and the response unit (user unit) decoding. And, as noted above, Von Kohorn discloses that encoding, and encryption are related (col 10, lines 40-45). And, the MPEP 2144.04 VI discloses that reversal or duplication is an

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obvious modification. Hence, reversing Von Kohorn so that the user unit encodes and the central station decodes is an obvious modification. Or, duplicating the encoder of the central station into the user unit and duplicating the decoder of the user unit into the central station is an obvious modification. Hence, transmitting the unique user identifiers in encrypted form is an obvious form of reversal or duplication.

4. Claims 47 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Von Hohorn (5,227,874) in view of Saigh (5,734,823) in view of [Crawford (6,411,943) OR Crawford (7,080,051)].

Please see the rejections stated above.

And, note the addition of the Crawford reference to the rejection stated above.

Von Kohorn does not explicitly disclose encrypting the transmitted unique user identifier.

However, Crawford (6,411,943) discloses encrypting the transmitted unique user identifier (claim 14).

Alternatively Crawford (7,080,051) discloses encrypting the transmitted unique user identifier (Claim 1).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Von Kohorn's transmitted unique identifier can be encrypted. One would have been motivated to do this in order to better secure the validity of the unique identifier of the user.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are not found persuasive. Please see the rejections above.

Also, please see the BPAI decision dated 2/8/2006 for this application 09/879,823 and particularly noted page 10. Also, please see the BPAI decision affirming the rejection of the claims for application 09/543,735 which has related features to this application 09/879,823.

Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Also, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). And, Examiner notes that claims are given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000).

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to. Also, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Also, Examiner notes that it must be presumed that the artisan knows something about the art apart from what the references disclose. *In re Jacobv*, 309 F.2d 513, 135 USPQ 317 (CCPA 1962). The problem cannot be approached on the basis that artisans would only know what they read in references; such artisans must be presumed to know something about the art apart from what the references disclose. *In re Jacoby*. Also, the conclusion of obviousness may

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be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint of suggestion a particular reference. In re Bozek, 416 F.2d 1385, USPQ 545 (CCPA 1969). And, every reference relies to some extent on knowledge or persons skilled in the art to complement that which is disclosed therein. In re Bode, 550 F.2d 656, USPQ 12 (CCPA 1977).

Also, Examiner notes that the person of ordinary skill in the art is a hypothetical person who is presumed to know the relevant prior art. Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc., 807 F.2d 955,962, 1 USPQ2d 1196, 1201 (Fed. Cir. 1986).

In determining this skill level, the court may consider various factors including "type of problems encountered in the art; prior art solutions to those problems; rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field." Id., cited in In re GPAC, 57 F.3d 1573, 1579, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995). In a given case, every factor may not be present, and one or more factors may predominate. Id. at 962-63, 1 USPQ2d at 1201.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Arthur Duran
Primary Examiner
1/11/2007